

(8)

Office - Supreme Court, U. S.

FILED

MAR 27 1943

CHARLES ELMORE DINGLEY  
CLERK

SUPREME COURT OF THE UNITED

STATES

OCTOBER TERM, 1942

---

No. 861

---

LEWIS W. GILBERT,

*Petitioner,*

*vs.*

GENERAL MOTORS CORPORATION.

---

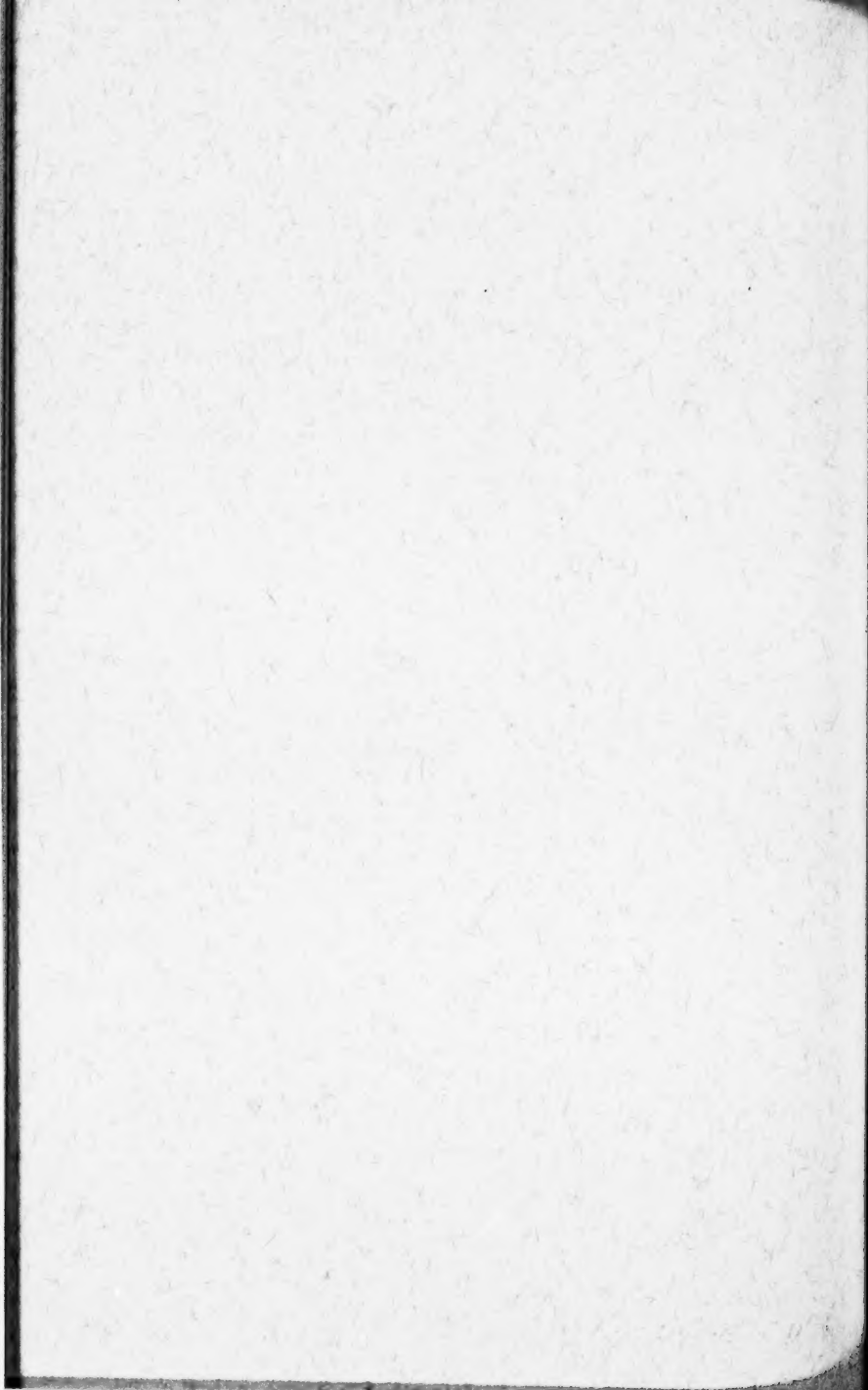
PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE SECOND CIRCUIT.

---

JOHN D. MEYER,  
*Counsel for Petitioner.*

HUGH J. O'BRIEN,  
FRANK KEIPER,

*Of Counsel.*



# INDEX.

## SUBJECT INDEX.

	Page
Opinions below.....	1
Jurisdiction.....	2
Questions presented.....	2
Statutes and rules involved.....	3
Statement.....	4
Specification of errors to be urged.....	6
Reasons for granting the writ.....	7
Summary on the facts.....	19
Summary of law involved.....	20
Conclusion.....	20

## CASES CITED.

<i>Adamson v. Gilliland</i> , 242 U. S. 350.....	8
<i>Allen Qualley Co. v. Shellmar Prod. Co.</i> , 31 Fed. (2nd) 293, <i>affd.</i> 36 Fed. (2nd) 623.....	9
<i>Becker v. Contour Laboratories</i> , 29 Fed. (2nd) 31, 279 U. S. 358.....	9
<i>Booth v. Stutz Motor Car Co.</i> , 56 Fed. (2nd) 962.....	9
<i>Bronson v. Carter Oil Co.</i> , 259 F. 656.....	15
<i>Central Trust Co. v. Chattanooga R. &amp; C. R. Co.</i> , 68 F. 685.....	15
<i>Chesapeake &amp; Ohio Rwy. Co. v. Kallenbach</i> , 96 Fed. (2nd) 301.....	9
<i>Cuno Engineering Corp. v. Automatic Devices Corp.</i> , 314 U. S. 84.....	10
<i>Des Moines Ex Parte</i> , 103 U. S. 794.....	13
<i>DuPont v. Masland</i> , 244 U. S. 100.....	9, 10
<i>Garlock Mercantile Co. v. Hughes Bozarth Anderson</i> , 180 S. W. 784.....	15
<i>Hanauer v. Siegel</i> , 29 F. Supp. 329.....	15
<i>The Harbour Trader</i> , 42 F. (2nd) 858.....	15
<i>Hoeltke v. C. M. Kemp Mfg. Co.</i> , 80 Fed. (2nd) 912, cert. denied 298 U. S. 673.....	7
<i>Holmes v. Phoenix Ins. Co.</i> , 98 F. (2nd) 240.....	15
<i>Jackson v. U. S.</i> , 295 F. 620.....	15

	Page
<i>Kraus v. General Motors Corp.</i> , 29 F. Supp. 431.....	15
<i>Laborde v. Ubarri</i> , 214 U. S. 173.....	12
<i>Manning Bowman Co. v. Keenan</i> , 73 N. Y. 45.....	15
<i>May v. Topping</i> , 64 S. E. 848.....	15
<i>McKee v. Grimm</i> , 57 Okl. 680.....	15
<i>Meinhard v. Salmon</i> , 249 N. Y. 458.....	10
<i>Orange Crush Co. v. American Ornamental Co.</i> , 60 Fed. (2nd) 518.....	8
<i>Picard v. United Aircraft Corp.</i> , 128 Fed. (2nd) 632...	10
<i>Reconstruction Finance Corp. v. Menihan</i> , 312 U. S. 81.	17
<i>Sanitary Refrigerator Co. v. Winters</i> , 280 U. S. 30.....	11
<i>Shelliday v. U. S.</i> , 25 F. (2nd) 372.....	15
<i>Smyth v. Kaufman</i> , 114 F. (2nd) 40.....	14, 15
<i>Frank C. Snedaker Co. v. Wayne Tille &amp; Trust Co.</i> , 20 Atl. (2nd) 819.....	15
<i>U. S. v. Bostich</i> , 289 F. 127.....	15
<i>U. S. v. Humbert</i> , 30 F. (2nd) 413.....	15
<i>U. S. v. Kidd</i> , 19 F. (2nd) 535.....	15
<i>U. S. v. One Dodge Coupe</i> , 13 F. (2nd) 1019.....	15
<i>U. S. v. One W. W. Shaw Automobile</i> , 272 F. 491.....	15
<i>Van Horne v. Hines</i> , 31 F. Supp. 346.....	15
<i>Washingtonian Pub. Co. v. Pearson</i> , 306 U. S. 30.....	13
<i>Wilson, Ex Parte</i> , 114 U. S. 417.....	13

## STATUTES.

Internal Revenue Code, Title 26 USCA, Sections 3443, 3481.....	17
Selective Service Act 1940, Title 50 USCA, Sections 303 (a), 303 (b), 521, 532 (3).....	18
Rule 36 a F. R. C. P.....	3, 14

## MISCELLANEOUS.

Proceedings American Bar Association, Institute on Federal Rules.....	14
--	----

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1942

---

**No. 861**

LEWIS W. GILBERT,

*vs.*

*Petitioner,*

GENERAL MOTORS CORPORATION.

---

**PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE SECOND CIRCUIT.**

---

Lewis W. Gilbert, a resident of the Village of Limestone, in the County of Cattaraugus, State of New York (hereinafter called the plaintiff) prays that a writ of certiorari issue to review the decree of the United States Circuit Court of Appeals for the Second Circuit, entered in the above cause on the fifth day of March 1943, which affirmed a certain decree of the United States District Court for the Western District of New York, entered on the 14th day of October, 1941, dismissing the amended complaint herein upon the merits.

**Opinions Below.**

The opinion of the District Court (R. 32) is reported 41 F. Supp. 525. The opinion of the Circuit Court of Appeals (R. 861) is not yet reported.

### Jurisdiction.

The decree of the Circuit Court of Appeals was entered March 5, 1943. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

### Questions Presented.

1. Does the submission by an inventor, in confidence, of his invention, to a manufacturer make the latter a trustee for the former, in relation to the invention confidentially disclosed?

2. In the event of such submission does the production by the manufacturer within a short time thereafter, of an article embodying the principles of the invention so submitted, cast upon the latter the burden of proving independent invention, or upon the inventor of proving the contrary?

3. Shall the standard of fidelity and loyalty of a trustee, once established for this Court by Mr. Justice Holmes (*Du-pont* case), and for State Courts by Judge, later Mr. Justice Cardozo, remain as so established, or be lowered by United States Circuit Courts of Appeals?

4. Shall the construction placed upon Rule 36-a of the Federal Rules of Civil Procedure by the United States Circuit Court of Appeals in this case (the *unless* clause especially) now be adopted as correct in the face of prior decisions of this Court directly in conflict therewith, as well as of such decisions in conflict therewith by the Circuit Court of Appeals in other Circuits, and of such decisions in conflict therewith by the highest Courts of the several States?

5. Does not the frequent use of this "unless" clause, not only in Rule 36-a, but in others of the Federal Rules of Civil Procedure (twenty-eight times in all) require that its

meaning, whenever so used, be finally and judicially declared by this Court?

6. On the record in this case is the decision of the Circuit Court of Appeals to the effect that there is no interference in fact between the devices of the plaintiff and the defendant supported by any substantial evidence?

7. Upon the record in this case should the Circuit Court of Appeals have affirmed the decree of the District Court?

### **Statutes and Rules Involved.**

The only Rule directly involved is Rule 36 a, of the Federal Rules of Civil Procedure. It provides as follows:

#### **36 (a) Admission of Facts and of Genuineness of Documents**

**Request for Admission.** At any time after the pleadings are closed, a party may serve upon any other party a written request for the admission by the latter of the genuineness of any relevant documents described in and exhibited with the request or of the truth of any relevant matters of fact set forth therein. Copies of the documents shall be delivered with the request unless copies have already been furnished. Each of the matters of which an admission is requested shall be deemed admitted unless, within a period designated in the request, not less than 10 days after service thereof or within such further time as the court may allow on motion and notice, the party to whom the request is directed serves upon the party requesting the admission a sworn statement either denying specifically the matters of which an admission is requested or setting forth in detail the reasons why he cannot truthfully either admit or deny those matters.

Indirectly involved is the construction of Rules 5, 6, 7, 8 b, 12 a, 26 b, 26 d (3), 30 e, 32 b, 32 c (1), 32 c (2), 32 a (3), 32 d, 33, 37 c, 39, 40 a (2), 40 b, 54 d, 55, 58, 61, 65 b, 67 c and

80 c. Indirectly involved also is the construction of many statutes, including the Selective Service Act of 1940, and the Internal Revenue Code.

### **Statement.**

This is a suit by the petitioner to charge the respondent as trustee ex maleficio for the plaintiff of an unpatented invention submitted by the plaintiff in confidence and fraudulently appropriated by it. Federal jurisdiction is based upon diversity of citizenship. The District Court (W. D. N. Y.) found that there was no appropriation, and dismissed the complaint (R. 861, 39-47 incl.). The Circuit Court of Appeals affirmed (R. 861-870). Both Courts held, inferentially at least, that the burden was on the plaintiff—after proving the submission in confidence also to prove the appropriation (R. 42 h, 864-865). Both Courts held further that defendant's device was invented by one Dyer, an engineer in its employ, although Dyer nowhere says so, and that he was aided by an inspection of two other submissions to defendant, one by one Collins (R. 43, 865-866), although Dyer nowhere says so, the other by one Kauffman (R. 46, finding 20, R. 866), although Dyer nowhere says so. To reach this conclusion both Courts apparently ignored the effect of plaintiff's first submission to defendant at Rochester, N. Y., on September 10, 1931, although finding (R. 41, p (a), 864) on ample evidence (R. 864, 365) that it was made.

Both Courts found that the plaintiff's device and the Dyer device were essentially different in construction and operation (R. 39-41, 866), in the face of the claim made by Dyer in an interference in the Patent Office (No. 68,678); (R. 16, 17) to which petitioner was a party, in which Dyer asserted, under oath (R. 17, fol. 51 Patent Office Rule 93 following Section 88 of Title 35 U. S. C. A. at page 729, *ibid.* form 32 page 781) that the two devices were essentially



similar, the essential features of similarity being embodied in the count or claim of the interference, set out in full in paragraph "Ninth" of the amended complaint (R. 4, 16, paragraph 15). This finding was also made in the face of the fact, demonstrable by a slight examination of the two devices submitted (Exhibits 3, 4, 7, 39, 40) handed up herewith; that if the elements contained in the claim or count of the interference (No. 68,678) were taken away from either of these devices, neither would be operable.

Defendant's mainstay on the trial was the testimony of Dyer, in many vital instances wholly uncorroborated, both as to independent invention and essential difference, or non interference in fact (R. 578-522); and both Courts have made vital findings based upon this uncorroborated testimony (Finding 11, R. 44, 793).<sup>1</sup>

Prior to the trial plaintiff served upon defendant's counsel, pursuant to Rule 36 a, Federal Rules of Civil Procedure, certain requests for admissions. Responses were served, but they were not under oath. On the trial plaintiff introduced these requests for admissions in evidence (R. 259) together with admission of service (R. 259, 628). These were admitted without objection. They are found in the record at pages 619 to 627. The defendant did not offer the unverified responses. The trial court evidently overlooked the effect of these admissions, for no comment thereon appears in his opinion. After the record was stipulated on appeal (R. 851) defendant made a motion in the Circuit Court of Appeals to add its unverified responses to the record. The motion papers precede the opinion in the copies furnished for use in this Court. This motion was

---

<sup>1</sup> 1. The Circuit Court of Appeals (R. 865-866) has found that Dyer had the benefit of the devices submitted by Collins and Kauffman and perfected them. This necessarily implies a finding that Dyer's preliminary statement under oath in the interference, and his inventor's oath (Title 35 Section 35 U. S. C. Patent Office Rules 46-48) were both untrue.

denied as unnecessary (opinion p. 870) the Court holding that before the plaintiff could take advantage of defendant's failure to comply with the rule, he must prove such failure on the trial. The Court further held that if the "requests" were to be treated as admissions the plaintiff should prevail (last page of opinion). To deny to the plaintiff the benefit of this Rule, the Court was obliged to place upon the "unless" clause therein a construction which appears to be unique.

### **Specification of Errors To Be Urged.**

The Court below erred:

1. In holding that there was no evidence that Findley, the engineer of defendant at Rochester, New York, to whom plaintiff's device was submitted in confidence, informed other employes of the defendant of the essentials of the device so disclosed.

2. In holding that such submission, so made, failed to create a confidential relation, so as to make the defendant a trustee for the plaintiff in respect thereto.

3. In holding that the burden of proof was upon the plaintiff to establish that the defendant appropriated the ideas disclosed by such device and submission, instead of upon the defendant to show that it did not.

4. In holding that there was substantial evidence to support the finding of the trial Court that the two devices are so essentially unlike that one could not have been copied from the other.

5. In holding (a) that there was substantial evidence to support the findings of the trial Court to the effect that Dyer invented the defendant's switch (Defendant's Exhibit A 17, R. 647, introduced in evidence R. 387; Plaintiff's physical Exhibit 39 handed up herewith), and (b) that in so

doing Dyer had the benefit of the submissions of Collins and Kauffman.

6. In holding, as a matter of law, that there was no interference in fact between the two devices.

7. In holding that the assignment by Lachappelle of his patent application to the defendant in December 1936 (R. 559, introduced R. 545) is a complete defense to this action.

8. In holding that Rule 36 a, Federal Rules of Civil Procedure (the *unless* clause), is not self executing and automatic, and casts upon the party serving the requests the burden of establishing, upon the trial, non compliance by the party served.

9. In affirming the decree appealed from.

### **Reasons for Granting the Writ.**

1. The decision in this case is in direct conflict with *Hoeltke v. C. M. Kemp Mfg. Co.*, 80 Fed. (2nd) 912, 923 Fourth Circuit, cert. denied 298 U. S. 673.

In *Hoeltke v. Kemp*, supra, the Fourth Circuit held that when a submission is made, as in the case at bar, by an inventor to a manufacturer, and the latter proceeds thereafter to manufacture articles of similar character, the latter, when called to account, must, if he asserts that he is using his own ideas, and not the ideas imparted to him by the inventor, prove his contention by evidence clear, convincing and beyond a reasonable doubt. In that case the unsuccessful defendant petitioned for a writ of certiorari. The four large motor companies, Ford, Packard, Chrysler and General Motors, asked leave to file a brief as amici curiae. Their brief in support of this motion urged that the Circuit Court was in error in holding that the submission created (a) relation of trust and confidence, (b)

that a failure of the manufacturer to disclose, at the time of the submission, its own development work along similar lines raised a presumption of bad faith and fraud, and (c) that such a manufacturer has the heavy burden of proving its innocence of fraudulently appropriating the invention submitted. This motion to intervene was denied (298 U. S. 672), and the petition for certiorari was also denied (298 U. S. 673). In the case at bar Dyer, defendant's mainstay, nowhere testified that he did not have any communication from Findley, defendant's engineer at Rochester, New York, between September 10, 1931, the date of the submission to the latter (R. 41, finding 6) and September 29, 1931, the date of the appearance of Exhibit A 17 (R. 643, int. R. 387). Nor was any supporting testimony given by any of the other engineers at defendant's plant at Anderson, Indiana. It must be remembered that Dyer in this suit is swearing that the two devices are essentially different, whereas in interference 68,678 he swore they were essentially the same. Irrespective of the rule requiring corroboration in patent cases, Dyer's testimony would seem to be valueless.

2. Both courts below held that there was no evidence that Findley communicated the result of his examination on September 10, 1931 to any of his associates (R. 42 h, R. 864, opinion CCA).

This ruling is also in direct conflict, not only with *Hoeltke v. C. M. Kemp Mfg. Co.*, but with *Orange Crush Co. v. American Ornamental Co.*, 60 Fed. (2nd) 518, 520, CCA 4, and with the principle of *Adamson v. Gilliland*, 242 U. S. 350. "The similarity of defendant's device to that of the plaintiff is strong proof that one was copied from the other" (*Hoeltke v. Kemp*, supra).

This ruling is also in substantial conflict with the following decisions of this Court and of other Circuits, both as

to the creation of the trust relationship and the burden of proof:

*Chesapeake & Ohio Rwy. Co. v. Kaltenbach*, 96 Fed. (2nd) 301, 306, CCA 4.

*Booth v. Stutz Motor Car Co.*, 56 Fed. (2nd) 962, CCA 7.

*Becker v. Contour Laboratories*, 29 Fed. (2nd), 31, 279 U. S. 358.

*Allen Qualley Co. v. Shellmar Products Co.*, 31 Fed. (2nd) 293, 296, *affd.* 36 Fed. (2nd), 623, CCA 7.

*DuPont v. Masland*, 244 U. S. 100.

3. The court below found that there was substantial evidence to support its statement that Dyer adopted and adapted the switches of Collins and Kauffman to perfect A 17. Dyer makes no such assertion. It was taken bodily as true from the brief of defense counsel, and is not only unsupported by any evidence whatever, but is contradicted by defendant's own documentary evidence.

Collins submitted his device (drawing and specifications) to defendant on February 2, 1931 (Defendant's Exhibits C 3, C 4, R. 675, 677, introduced R. 441). On April 24, 1931 defendant's New Devices Committee returned these to Collins with the usual letter of condolence, (Exhibit C 11, R. 685, introduced 441). They were again returned on October 10, 1931 (C 18, R. 693, introduced R. 441) and are shown in the drawings on pages 715, 716 and 717 of the record (introduced R. 441). *They do not disclose the central helical spring* (2 in Dyer) which performs the important function of bringing the contact points together in plaintiff's device, as against the suction of the vacuum, and of bringing the contact points into the same plane in the Dyer device, as against the suction of the vacuum. Collins uses gravity instead of a spring.

Kauffman's device (drawings) were submitted on October 16, 1931, after A 17 appeared (Exhibit D 5, R. 738, int.

R. 489) and returned to him on March 8, 1934, having become mislaid in the meantime. (Exhibit D 6, R. 740, int. R. 489).

The suggestion that Dyer was aided by Kaufman comes alone from defense counsel, not from Dyer. Incidentally, they accuse defendant of fraudulently misappropriating Kauffman's ideas in 1931, and making a belated reparation in 1937 (R. 562, int. R. 548). The court below has found this misappropriation as a fact (opinion A. 865-866).

4. The Circuit Court of Appeals held (opinion R. 869) that the assignment of this patent application by Lachappelle to the defendant was a complete defense. An abstract of this assignment is found at page 559 (int. R. 545 (3)). It is dated December 10, 1936—more than five years after plaintiff's submission to defendant. Lachappelle later was awarded priority in interference 68,678 by default (127 Fed. (2nd) 750).

This ruling is in direct conflict with the decision of this Court (per Mr. Justice Holmes) in *DuPont de Nemours Powder Co. v. Masland*, 244 U. S. 100, and of Mr. Justice (Then Chief Judge) Cardozo, speaking for the New York State Court of Appeals in *Meinhard v. Salmon*, 249 N. Y. 458 at page 464.<sup>2</sup>

What passed by the Lachappelle assignment was the right to obtain a patent and to prosecute for infringement thereof, both probably valueless (*Cuno Engineering Corp. v. Automatic Devices Corp.* 314 U. S. 84, 90, 91). What did not pass was the right to copy plaintiff's device and to use his ideas without paying for them, or accounting for the profits from such use, at least for the period before defendant ever heard of Lachappelle (Pleadings, answer R. 18, paragraph 18).

---

<sup>2</sup> It is also in conflict with *Picard v. United Aircraft Corp.*, 128 Fed. (2nd) 632, 637, C. C. A. 2.

5. Both Courts below held that there was substantial evidence that the two devices, plaintiff's and Dyer's, were so essentially different as to negative the claim of copying, or, in the language of the decision below, that there was no interference in fact. This despite the claim of Dyer of substantial identity in interference 68,678. This ruling is in conflict with the decision of this Court in *Sanitary Refrigerator Co. v. Winters* 280, U. S. 30, pp. 41, 42, the difference here being in form only. A brief comparison is unavoidable.

A. Both devices are vacuum controlled starter switches for automobiles. Gilbert's (called in the opinion below his third switch, R. 864) consists of a cylinder containing a piston. At the head of the cylinder is a contact point, which, when the piston is shoved up as far as it would go, meets another contact point inside the cylinder, closes the circuit and sets the starting motor into operation. This shoving is accomplished by the expansion of a helical spring inside the cylinder and below the piston. A tube runs from the cylinder below the piston to the intake manifold. When the engine starts the vacuum created in the intake manifold compresses the spring, pulls the contact points apart and breaks the circuit. To provide against a failure in vacuum for any cause a wire attached to the bottom of the cylinder is carried to the accelerator rod, so that the contact points cannot come together so long as the accelerator rod is depressed.<sup>3</sup>

B. Dyer substitutes a diaphragm for the cylinder, and a rod attached to the center of the diaphragm for the piston.

---

<sup>3</sup> Gilbert's device is handed up with this petition. Exhibit 3 shows the device as invented in 1928 (R. 577 int. R. 72). Exhibit 7 is a replica of the device submitted to the defendant on September 10, 1931 (R. 585 int. R. 93). Exhibit 4 (R. 577 int. R. 74), is a model of Exhibits 3 and 7, constructed for the purposes of this trial, with the front cut away and a glass window inserted to disclose the operation of the parts.

These are mechanical equivalents (Kauffman R. 487, Exhibit D 8, R. 472, 2nd line of legend, int. R. 486). Above and below the diaphragm are two helical springs, designed to force the contact points into the same place. Above the diaphragm is a vacuum tube running from the intake manifold into the vacuum chamber. The suction of the vacuum moves the diaphragm, which pulls up the rod to break the contact by opening the circuit (Dyer R. 395).<sup>4</sup>

To these features, present in both devices, Dyer substituted for Gilbert's butt contact a sliding or wiping contact, by copying the mechanism found in the socket of every chain operated electric light in the country. The latter mechanism consists of a disk or wheel on which the end of the chain rides and to which it is attached, a torque spring to reverse the action of the wheel and return the chain to its original position, a clutch connecting this wheel to a ratchet shaped wheel or disk with high and low points on its circumference and an arc shaped metal leaf which touches the high points on the ratchet shaped wheel and closes the circuit. Another pull on the chain moves the ratchet shaped wheel sufficiently so that the arc shaped leaf is no longer in contact and the circuit is broken.

In the Dyer device the attachment to the accelerator rod takes the place of the chain as used in the lamp socket. The other features, clutch, torque spring, reverse movement on

---

<sup>4</sup> 1. Exhibits 39 and 40, physical exhibits, introduced R. 228, are also handed up with the petition. They are defendant's Dyer Buick switches (R. 228). Windows have been cut in Exhibit 39 so that the Court can see the diaphragm and the two helical springs, one above and one below it.

2. The drawings A 13 (R. 640), A 15 (R. 641) and A 16 (R. 642), all introduced R. 387, would seem entitled to little, if any, credit as contemporary documents. They rest upon the unsupported testimony of Dyer. The witness, if any, to A 13 was not produced. The signature of W. C. Edwards appears on A 15 and A 16. He testified (R. 409 et seq.) but said nothing to corroborate Dyer. Had these been contemporary documents they would have been marked in evidence in interference 68,678, cf. A 17, R. 643.



release of the operator's hand (or foot) are all present in both.

Under these circumstances the Patent Office, in framing the count of interference 68,678, covered these apparent differences by the use of the words "control" and "controlling" (R. 4, paragraph ninth). So read, the count of interference 68,678 covers both plaintiff and Dyer.

6. The most important reason (from a public point of view) for granting the writ is to be found in the construction placed upon the "unless" clause in Rule 36.a, F. R. C. P. "*Unless* within a period designated in the request . . . the party to whom the request is directed serves . . . a sworn statement." The learned Court held that this Rule is not self-executing; in other words, that the party seeking the benefit of the Rule must prove a negative. The *unless* clause appears in twenty-seven other places in these Rules and in various statutes mentioned below. This interpretation is in direct conflict with the intent of the Rule as formulated by the American Bar Association Institute on Federal Rules. We take the liberty of quoting Professor Sunderland:<sup>5</sup>

"A very extensive discovery by way of admissions of particular facts and documents is provided for by Rule 36. Under that Rule any party may serve on any other party a request for the admission of any facts or the genuineness of any designated documents, and upon such request they will be deemed admitted, unless the party served with notice shall within ten days serve a sworn statement upon the party requesting the admission specifically denying the matters specified in

---

<sup>5</sup> (Proceedings of the American Bar Association Institute July 22, 1938, page 289.

In *Smyth v. Kaufman*, 114 F. (2nd) 40 at page 42 Judge Hand cites the Proceedings of the Institute, pp. 103, 142, 263. His may be a different edition.)

the request or stating why he cannot either admit or deny them.

The usual statute or rule on admissions requires affirmative action to constitute the admission, but under this rule affirmative action is required to avoid the admission.<sup>46</sup> There must be, therefore, a sworn statement specifically denying the facts which the other party requests should be admitted or the admissions will be deemed to have taken place."

This interpretation is also in direct conflict with the interpretation placed upon similar *unless* clauses by the following authorities:

1. *Supreme Court of the United States Ex Parte Wilson*, 114 U. S. 417.

This case arose under the Fifth Amendment "unless on a presentment of indictment of a grand jury." This Court held the Amendment self-executing in the following words, (p. 426):

"The purpose of the Amendment was to limit the powers of the Legislature, as well as of the prosecuting officers, of the United States. We are not, indeed, disposed to deny that a crime, to the conviction and punishment of which Congress has super-added a disqualification to hold office, is thereby made infamous. *U. S. v. Waddell*, 112 U. S. 76, 82; S. C. ante, 35. But the constitution protecting everyone from being prosecuted, without the intervention of a grand jury, for any crime which is subject by law to an infamous punishment, no declaration of Congress is needed to secure or competent to defeat the constitutional safeguard."

*Laborde v. Ubarri*, 214 U. S. 173;

*Ex Parte Des Moines, etc.*, 103 U. S. 794, 796;

*Washingtonian Pub. Co. v. Pearson*, 306 U. S. 30, 39.

---

<sup>46</sup> English Rules Under the Judicature Act (The Annual Practice 1937) O. 32, r. 4; see Rule 18.

## 2. Circuit Courts of Appeals

- CCA (4); *Shelliday v. U. S.*, 25 F. (2nd) 372;  
 CCA (2); *The Harbour Trader*, 42 F. (2nd) 858;  
 CCA (9); *Bronson v. Carter Oil Co.*, 259 F. 656, 663;  
 CCA (8); *Holmes v. Phoenix Ins. Co.*, 98 F. (2nd) 240, 241;  
 CCA (9); *Jackson v. U. S.*, 295 F. 620, reversing *U. S. v. Bostich*, 289 F. 127, 129;  
 CCA (4); *Central Trust Co. v. Chattanooga R. & C. R. Co.*, 69 F. 685, 696.

## 3. District Courts

- New York—*Kraus v. General Motors Corp.*, 29 F. Supp. 431;  
 District of Columbia—*Van Horne v. Hines*, 31 F. Supp. 346;  
 Illinois—*Hanauer v. Siegel*, 29 F. Supp. 329, cited in *Smyth v. Kaufman*, 114 F. 2nd 40, 42, supra;  
 Idaho—*U. S. v. Kidd*, 19 F. 2nd, 535, 536;  
 Kansas—*U. S. v. Humberd*, 30 F. 2nd 413, 415;  
 Tennessee—*U. S. v. One Dodge Coupe*, 13 F. 2nd, 1019;  
 Ohio—*U. S. v. One W. W. Shaw Automobile*, 272 F. 491.

## 4. State Courts

- New York—*Manning Bowman Co. v. Keenan*, 73 N. Y. 45, 56.  
 Texas—*Garlock Mercantile Co. v. Hughes Bozarth Anderson*, 180 S. W. 784, 790;  
 West Va.—*May v. Topping*, 64 S. E. 848, 849.  
 Pennsylvania—*Frank C. Snedaker & Co. v. Wayne Title & Trust Co.*, 20 Atl. (2nd) 819, 822;  
 Oklahoma—*McKee v. Grimm*, 57 Okl. 680, 157 P. 308.

The above list is not asserted to be complete. It does show general uniformity in the construction of the "unless" clause, wherever it appears in constitution, law or rule. Such construction makes the constitutional provision, the statute or the rule self-executing and automatic.

The opinion of the Circuit Court of Appeals in the case at bar is in direct conflict with this construction. It comes from a high Court and, as such, is entitled to respect and, to some extent, obedience by the District Courts. If allowed to stand, it will cause endless confusion in the bench and bar, not only as to this rule, but as to every other rule where the "unless" clause is used. A list follows:

Rule 5. *Unless* the Court otherwise orders.

Rule 6. *Unless* it is a Sunday or other legal holiday.

Rule 7. An application to the Court shall be by motion, which, *unless* made during a hearing, shall be made in writing.

Rule 8. *Unless* the pleader intends in good faith, etc.

Rule 12. (a) *Unless* the Court otherwise directs (first sentence),

*Unless* a different time is fixed by the Court.

Rule 26. *Unless* otherwise ordered by the Court.

Rule 26. (d) (3) *Unless* it appears that the absence of the witness, etc.

Rule 30. (c) The testimony shall be taken stenographically and transcribed *unless* the parties agree otherwise.

Rule 30. (e) The deposition shall be signed by the witness *unless* such examination and reading are waived by the witness and by the parties.

Rule 32. (b) *Unless* made before the taking of the deposition.

Ibid. (c) 1. *Unless* the ground of the opposition.

Ibid. (c) 2. *Unless* seasonable objection is made.

Ibid. (c) 3. Objections \* \* \* are waived *unless* served in writing.

Ibid. (d) *Unless* a motion to suppress is made.

Rule 33. *Unless* the Court \* \* \* enlarges the time.

Rule 37. (c) *Unless* the Court finds, etc.

Rule 39. The trial of all issues shall be by jury *unless* (1) the parties stipulate or (2) the Court finds, etc.

Rule 40. (a) 2. *Unless* otherwise specified, etc.

Ibid. (b) *Unless* the Court otherwise specifies.

Rule 54. (d) *Unless* the Court otherwise directs.<sup>6</sup>

Rule 55. No judgment shall be entered against an infant or incompetent person *unless* represented, etc.

Rule 58. *Unless* the Court otherwise directs.

Rule 61. *Unless* refusal to take such action.

Rule 62. *Unless* otherwise ordered by the Court.

Rule 65. (b) *Unless* it appears, etc. "*Unless* within the time so fixed the order, for good cause shown, is extended for a like period, or *unless* the party \* \* \* consents."

Rule 72. (c) *Unless* the Court fixes a different amount.

Ibid. (d) *Unless* the Court \* \* \* fixes a different amount.

Rule 80. (c) Repleading is not necessary *unless* the Court so orders.

The following are taken at random from the Revised Statutes:

*Internal Revenue Code.*

Section 3443: "(d) No overpayment of tax under this chapter shall be credited or refunded (otherwise than under subsection (a)), in pursuance of a court decision or otherwise, *unless* the person who paid the tax establishes, in accordance with regulations prescribed by the Commissioner with the approval of the Secretary, (1) that he has not included the tax in the price of the article with respect to which it was imposed, or collected the amount of tax from the vendee, or (2) that he has repaid the amount of the tax to the ultimate purchaser of the article, or *unless* he files with the Commissioner written consent of such ultimate purchaser to the allowance of the credit or refund."

Title 26 U. S. C. A., Section 3443, p. 195 (53 Stat. 417).

Section 3481: "(a) 2. No delivery or transfer to a nominee shall be exempt under this paragraph *unless* such

<sup>6</sup> Certiorari was granted to provide a uniform interpretation of Rule 54 (d) in *Reconstruction Finance Corporation v. Menihan* (311 U. S. 625). This Rule contains an "unless" clause. The learned Attorney General was too sane to argue that this clause was to be construed as having other than its generally accepted meaning (312 U. S. 81).

nominee, in accordance with regulations prescribed by the Commissioner, with the approval of the Secretary, is registered with the Commissioner."

Title 26 U. S. C. A., Section 3481 (a) 2, p. 210.

Title 1 Section 1 (53 Stat. 862).

*Selective Service Act of 1940.*

Section 303: "(a) Provided further that no citizen or subject of any country who has been or who may hereafter be proclaimed by the President to be an alien enemy of the United States shall be inducted for training and service under this Act *unless* he is acceptable to the land or naval forces. \* \* \*

"Provided further that no man shall be inducted for training and service under this Act *unless* and until he is acceptable to the land or naval forces."

Section 303: "(b) Each man inducted under the provisions of subsection (a) shall serve for a training and service period of twelve consecutive months *unless* sooner discharged."

Title 50 U. S. C. A., 114, 54 Stat. 885, 55 Stat. 627, 846.

Section 521: "*Unless*, in the opinion of the Court, the ability of plaintiff to prosecute the action or the defendant to conduct his defense."

Title 50 U. S. C. A. 148, 54 Stat. 1181.

Section 532: "(3) *Unless* upon an order of sale previously granted by the Court."

Title 50 U. S. C. A. 152, 54 Stat. 1182.

In the foregoing the sentence containing the "unless" clause would appear to be self-executing. No doubt many other illustrations might be found in the Statutes, but we limited our attention to two in every day use, not only by the judiciary but by governmental departments.

It is difficult to see how the District Courts can uniformly interpret the Rules of Civil Procedure in the face of the construction given below in this case, which must either be

blindly followed or dissented from. Since the Court below held (last page of opinion p. 869) that these requests for admissions, not answered under oath, established the plaintiff's whole case; the result to the petitioner of this emasculation of these rules can hardly be exaggerated.<sup>7</sup>

### **Summary on the Facts.**

1. Plaintiff was the first to submit to defendant a device containing all the elements described in interference 68,678 (R. 4, par. Ninth), and now an integral part of defendant's switch.

2. Dyer does not claim invention in himself, and, if he made such claim, should not be believed without corroboration, in view of his Protean capabilities as a witness.

3. Dyer could not get from Collins what Collins did not have.

4. Dyer acknowledges no indebtedness to Kauffman. Both Courts below were asked to believe, and in part did believe, that defendant stole Kauffman's ideas in 1931, lied to him about them in 1934 (Exhibit D 6, R. 740, int. R. 489) and purchased his testimony in 1936 (R. 562, 564, fols. 1690, 1691, int. R. 548, Kauffman R. 495). While possibly indicative of a state of mind, this is not true. Kauffman's submission on October 16, 1931 (Exhibit D 5, R. 738, int. R. 489) was too late. Exhibit A 17 (R. 643, int. R. 387) and Exhibits A 18 to 35 (R. 644, 645, 646, int. R. 369) had already appeared.

---

<sup>7</sup> There is no suggestion in the record or otherwise that these requests were answered under oath. The defendant's plea of waiver of compliance with this rule, made to the Circuit Court of Appeals, is in itself proof of non-compliance.

### Summary of Law Involved.

1. The proposition advanced by the four large motor companies in their motion to intervene in *Hoeltke v. C. M. Kemp Mfg. Company*, supra, and rejected by this Court (298 U. S. 673), has, by the decision below in this case, become established law. The inventor is left wholly at the mercy of the manufacturer.

2. The efforts of this Court, of the Congress, of lower Federal Courts, of the American Bar Association and its Institute, to draft a simple and comprehensive set of Rules for District Courts, must, in the face of this decision, be deemed to have entirely failed if these Rules, or any of them, can be whittled away because of a desire to relieve a supposed hardship in a particular case.

### Conclusion.

Wherefore it is respectfully submitted that this petition for a writ of certiorari should be granted.

JOHN D. MEYER,  
Counsel for Petitioner,  
Gulf Building,  
Pittsburgh, Pennsylvania.

HUGH J. O'BRIEN,  
WERNER, HARRIS & TEW,  
FRANK KEIPER,  
Rochester, New York,  
Of Counsel.







9

Office - Supreme Court, U. S.

FILED

APR 20 1943

CHARLES ELMORE GROPLEY  
CLERK

# Supreme Court of the United States

OCTOBER TERM 1942

---

No. 861

---

LEWIS W. GILBERT,

*Petitioner,*

*vs.*

GENERAL MOTORS CORPORATION,

*Respondent.*

---

## BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

---

DRURY W. COOPER  
ALLAN C. BAKEWELL

*Attorneys for Respondent.*



# INDEX

	PAGE
STATEMENT .....	1
ORIGIN OF THE BUICK SWITCH.....	8
THE PRIOR DEVICES OF COLLINS AND KAUFFMAN.....	11
ERRORS URGED BY PETITIONER.....	14
PETITIONER'S REASONS .....	17
PETITIONER'S SUMMARY OF FACTS AND LAW.....	20
CONCLUSION .....	20

## AUTHORITIES

<i>Burr v. Duryee</i> , 1 Wall. 531, 572.....	7
<i>General Talking Pictures Corp. v. Western Electric Co., et al.</i> , 304 U. S. 175, 178.....	15
<i>Gilbert v. General Motors</i> , 41 F. Supp. 525 (D. C. W. D. N. Y.).....	1
<i>Gilbert v. General Motors</i> , 56 U. S. Pat. Q. 483 (C. C. A. 2) .....	1
<i>Gilbert v. Lachapelle</i> , 127 F. [2d] 750 (U. S. C. A. D. C.) .....	10, 16
<i>Hoeltke v. C. M. Kemp Mfg. Co.</i> , 80 F. [2d] 912 (C. C. A. 7) .....	17, 20
<i>Texas &amp; New Orleans Railroad et al. v. Brotherhood of Railway &amp; Steamship Clerks et al.</i> , 281 U. S. 548.....	15
<i>Thompson Spot Welder Company v. Ford Motor Company</i> , 265 U. S. 445, 447.....	15
<i>Westinghouse v. Boyden Power Brake Co.</i> , 170 U. S. 537, 568 .....	7

## Statutes and Rules Cited

Revised Statutes, Section 4915 (35 U. S. C. 63 and 72a)	16
Rule 1 of the Rules of Civil Procedure.....	19
Rule 36 a of the Rules of Civil Procedure.....	18



# Supreme Court of the United States

OCTOBER TERM 1942

---

No. 861

---

LEWIS W. GILBERT,

*Petitioner,*

*vs.*

GENERAL MOTORS CORPORATION,

*Respondent.*

---

## BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Plaintiff's petition in many instances fails to distinguish between statements of fact, supported by the record, and mere argument of counsel *dehors* the record. We believe it necessary to restate some of the facts.

### Statement

This is a so-called "submission" case—i. e., plaintiff says defendant appropriated and used an idea submitted by plaintiff. It went to trial on a third amended complaint (R. 2) which alleges three separate confidential submissions to defendant of an unpatented switch, asserted to be novel, and claims damages for the subsequent copying and use of that switch by defendant on its Buick automobiles. The opinion of the District Court (R. 32) is reported in 41 F. Supp. 525 and that of the Court of Appeals (R. 861) in 56 U. S. Pat. Q. 483, not yet in Federal Reporter.

The primary question in an action such as this is one of fact: Did the defendant copy and use the device of

plaintiff? This question was answered in the negative by concurrent findings of both of the lower courts (R. 47 and R. 866):

"The Buick switch has nothing in common with that of Gilbert except use of vacuum control and a mechanical connection to the accelerator. These features are entirely different in construction and function in the Buick device and that of Gilbert."

Without proof of similarity of defendant's structure with that of plaintiff and the use of a similar mode of operation, there can be no liability on defendant's part and it makes no difference whether or not there was a confidential submission by plaintiff or whether or not the devices submitted were novel. The *fact* of confidential submission, the *fact* of novelty and the *fact* of copying by defendant must all be proven. As plaintiff's counsel said on the trial (R. 68):

"As I said, unless we establish priority, we are just out the window, because if they knew all about it, as they say they did, that is an important issue. \* \* \* Now, as I say, we have to establish priority or we are out, even though there was a disclosure and even though they copied our device. We had no property rights in it if it was anticipated by somebody else, whether they knew about it or not, if they found it out later."

And again (R. 72):

"\* \* \* [plaintiff] is obliged to establish that they took from him something that was original with him. That is his case. If they took something from somebody else, then, of course, he is out of luck. It doesn't make much difference whether they took it before or after the disclosure because he no longer has any originality. The date of the invention is highly material here."

The question of novelty of plaintiff's switch was likewise found against plaintiff by the concurrent findings of both courts below (R. 47 and R. 866):



"These features are both found in the prior devices of Kauffman<sup>1</sup> and Collins."

The third issue in such an action for damages is the *fact* of a confidential submission. Both courts found that plaintiff's switch was first submitted on September 10, 1931 by one Watkins, acting for plaintiff, to Findley, an employee of defendant's Delco Appliance Division at Rochester, N. Y. This division manufactured only *household appliances*. The courts also found that neither Findley nor Watkins took the switch apart or made a sketch of it (R. 864); further it was found by both courts that there was no evidence that Findley (R. 42) ever told any of defendant's other employees what he learned of it (admittedly Findley himself had nothing to do with the defendant's design or manufacture of the Buick switch). There was no finding that the disclosure to Findley was in confidence, and not an iota of evidence to that effect.

That Watkins did visit Findley on September 10, 1931 is proved by two letters in evidence which were written after the visit (R. 566 and R. 567), but defendant doubts that the switch actually shown to Findley was the plaintiff's switch here in controversy. Rather it seems that what Watkins did show to Findley was an earlier switch, already patented and that switch admittedly was never used by defendant. That earlier patented switch is the only one mentioned in the correspondence (and it is shown in a drawing placed on one of the letters by Gilbert himself, R. 566); this was found to be the fact by the District Court and the finding was not disturbed by the Court of Appeals (R. 42, findings 2e, 2f and 2g). Unfortunately Findley died several years before the complaint was filed (R. 42) and was not available to testify for defendant.

Watkins alone testified by deposition (R. 260-323) as to what was said and done at the Rochester visit and the only items of documentary evidence were the two letters above

---

<sup>1</sup> The prior switches of Kauffman and Collins will be described at p. 11 of this brief and their significance explained.

referred to. Watkins was not produced at the trial as he was subject to arrest in New York State (plaintiff's witness, Yells, Sheriff of Seneca County, N. Y., R. 256). By his own assertion he was not a disinterested witness for he claimed a 24½% interest in Gilbert's switch (R. 318). Watkins was believed only in part (R. 42) and even he never testified that he had submitted whatever he did submit to Findley, in confidence. The device said to have been submitted *was not produced in Court nor otherwise accounted for*, though Watkins said he thought Gilbert had it (R. 314) and Gilbert never denied it.

While defendant does not believe that there is adequate proof of the fact that Watkins showed the plaintiff's device in question to Findley, it will not here urge a ruling contrary to the concurrent findings of the lower courts. But it does most strenuously contend that Watkins' testimony establishes neither the existence of a confidential disclosure—the two persons present thought they (R. 42, g) were talking about the device of a publicly issued patent—nor does it establish the *use* of the disclosed device by defendant.

Both courts found as a fact that the evidence did not sustain the allegation (R. 5, fol. 14) of a *second* submission to defendant (R. 42, 43; R. 864, 865) which was asserted to have taken place in Detroit. No further regard need be given to this allegation because petitioner, now, has apparently abandoned it.

The *third* alleged submission took place on January 7, 1932 when one of plaintiff's switches was sent to Prescott (R. 588), one of defendant's engineers at Anderson, Indiana. Also on January 11, 1932 a copy of Gilbert's patent application (filed October 13, 1931) and some instructions for installing his switch (R. 596, 597) were sent to defendant. There is considerable correspondence in evidence; a letter of February 26, 1932 (R. 600) from Gilbert's associate is of particular significance for it accentuates a distinctive feature of the operation of Gilbert's switch which is not present in the accused switch of Buick:

"The wire which attaches to the throttle arm, *has no function in starting the starter; but serves to keep the starter cut out as long as the throttle is open.*"

Plaintiff offered no proof that this 1932 submission was either intended, or understood to be, in confidence; indeed, it was demonstrated that prior to that time plaintiff had generally (R. 107-109, 159, 205) offered his switch to other companies without any attempt to keep the matter confidential and had sold one of them to a company for twenty dollars. But regardless of this fact, plaintiff was held not entitled to any recovery here because defendant had already designed and adopted its own switch and this switch is essentially different in structure and mode of operation from that of plaintiff.

Before discussing the origin and history of the Buick switch we will describe the defendant's switch and compare it with that of plaintiff. The descriptions and comparison in the petition are inadequate (p. 11) and confusing. Both courts found essential differences between the structures of the two switches and specifically held that they were designed for a different purpose and operated in a different manner (R. 46, findings 22, 23; R. 866, 868):

1). In the device of Gilbert, the control switch is *normally closed* and the only thing which must be done to cause the starting motor to become operative is to close the ignition switch. This device is known in the record as a "key start" device. Defendant's device on the other hand employs a *normally open* control switch and the mere closing of the ignition switch will not cause operation of the starting motor (R. 39, finding 2 (a); R. 866; last par.) and it is, therefore, not a "key start" device.

2). The mechanical connection between accelerator pedal and switch performs a different function in the two devices. With plaintiff, depression of the accelerator pedal either pulls the contacts apart when the engine is not running or holds them apart if the engine stalls so as *to prevent the*

*closing* of the electrical starter circuit. As was said in plaintiff's letter of February 26, 1932 (*supra*, p. 4; R. 600):

"The wire which attaches to the throttle arm *has no function in starting the starter* \* \* \*."

Defendant's switch operates entirely differently; depression of the accelerator pedal is used *to close the starter circuit* and is not used *to prevent the closing of the starter circuit* (R. 39, finding 2 (b and c); R. 867, last par.; Dyer, R. 518-522).

3). In plaintiff's device one of the electrical contacts is mounted on the piston and the vacuum created in the manifold of the engine, when it has started to operate under its own power, *pulls* the contacts apart and upon a drop in vacuum, if the engine stalls or is stopped by the operator, the contacts will automatically close under the influence of a spring unless prevented by the continued depression of the accelerator pedal. Vacuum, on the other hand, *does not pull the contacts apart* in defendant's device nor does it hold them apart; vacuum merely declutches or disables the connection between the accelerator pedal and switch operating arm so that the contact of the switch is permitted to rotate to open position under the influence of a torsion spring. With defendant's switch, if the vacuum should drop, the switch contacts will *not automatically close*, regardless of whether the accelerator is held in either a depressed or an off position (R. 40; findings 2 d and e; R. 866, last par.).

4). With plaintiff's switch there will be an automatic restarting of the engine, should it stall, unless the switch contacts are held apart by the operator, whereas with defendant's device nothing will happen if the engine stalls until the operator redeclutches the switch operating arm by taking his foot off of the accelerator pedal and again *depresses* the accelerator pedal to rotate the switch contacts to closed position (R. 40, 41, findings 2 (h) and (i); R. 866, fol. 871).

Because of these radical differences between the devices of plaintiff and defendant, it was inevitable that the Court of Appeals should agree with the District Court and say (R. 866):

"The Buick switch has nothing in common with that of Gilbert except use of vacuum control and a mechanical connection to the accelerator. These features are entirely different in construction and function in the Buick device and that of Gilbert."

Under this state of facts, conclusively established by defendant's proofs and not questioned by any of plaintiff's witnesses, no court could find that defendant has in fact copied the device of the plaintiff Gilbert and is liable to account to him. The two devices are distinctly different in construction, mode of operation and result.

*Burr v. Duryee*, 1 Wall. 531, 572.

*Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537, 568.

It is significant that plaintiff's petition totally disregards the testimony of his only witness in regard to the structure and operation of the Buick switch and relies upon arguments of counsel which are not based upon anything in the record. For example, the claimed similarity of defendant's device to an electric light socket (petition, p. 12): nowhere in the Record is there any basis for this statement and it has never been used by counsel before it appeared in the petition; also mechanically it is incorrect. Plaintiff's sole witness on the operation of defendant's switch was Mr. Frank Keiper, who was attorney of record for plaintiff below and is on the petition as of counsel here. It developed on cross-examination that he knew very little about the structure and operation of the Buick switch (R. 232).

### Origin of the Buick Switch

The Buick switch was designed by John B. Dyer, plaintiff's engineer at Anderson, Indiana. He started his development work in April, 1931 (R. 327) in connection with some earlier vacuum switches designed for defendant by Hill and Blake (R. 420). On September 10, 1931 (R. 640) Dyer designed his first starter, which was not of the "key-start" type (R. 356) but required the manual operation of the accelerator pedal. The drawing and a long report (R. 637), dated September 15, 1931, are in evidence. The report is of interest because it shows that Dyer already knew about a manually operated vacuum switch designed by Collins which had been submitted to defendant (R. 672) in January, 1931. The Collins' switch is like that of Buick (R. 519) in that it is a normally open switch and depression of the accelerator pedal is necessary in order to close the switch (findings 16-19, R. 45; R. 866; *infra*, p. 11).

On September 29, 1931 Dyer (R. 359) made a drawing of a vacuum operated starter switch (Ex. A-17; R. 643) in which the accelerator pedal is used to close the starter circuit and in which vacuum disables the connection between the accelerator pedal and the switch closing lever of the switch. Drop in vacuum will not recouple the connector but it is necessary for the operator to return the accelerator to the normal position and again depress it to close the switch. In other words, it is not a "key-start" device like Gilbert's, but is a normally open switch closed manually to crank the engine, like that of Buick.

Immediately after Dyer made his sketch on September 29, 1931 working drawings were prepared (the date, October 10, 1931 is now *conceded*, R. 646) and the device constructed (physical exhibit, A-59) and put in operation on a car on November 3, 1931 (Ex. A-37, R. 649).

*Dyer testified (R. 384) that he had never heard of Gilbert or his switch at the time he made and operated Exhibit A-59, and did not learn anything of it until the Spring of*

1932 (R. 350). Dyer did, however, know about Collins' device even as early as the date of his drawing, A-13, which was made September 10, 1931—this fact was reluctantly admitted in plaintiff's brief in the Court of Appeals (p. 37):

"Nevertheless, we cannot deny that Dyer might have learned something of the Collins device, or scheme, as he puts it, early in September, 1931. His letter (Defendant's A 12, R. 637) indicates that, and also indicates that he has embodied this scheme in Defendant's A 13."<sup>2</sup>

The next type of switch designed by Dyer is in evidence as Exhibit A-58 and is shown in a series of drawings dated November 17, 1931 (Exs. A-41 to A-47; R. 654). This device differs from Exhibit A-17 (Sept. 29, 1931) and from the *commercial* Buick switch (Ex. A-62) in that vacuum pulls the contacts apart but it is like those switches in that the contacts are closed by operating the foot accelerator as distinguished from Gilbert's "key-start" device. As Dyer had already designed and operated A-17 which Buick followed, this A-58 of November 17, 1931 switch is of interest here merely because petitioner, without any basis in the record, has again and again asserted that a patent application filed on the Buick *commercial* switch was in interference with Gilbert in the Patent Office. This assertion is contrary to the fact. The fact is that the Buick switch application of Dyer was never in any interference, whereas the Dyer application disclosing the A-58 switch was in interference with Gilbert and Lachapelle.

It is incredible that petitioner should continue the misstatements about the interference unless he still does not understand the operation of the Buick switch, for Mr. Keiper was attorney for the Gilbert application in the Patent Office and must be familiar with the particular Dyer application there involved and the Dyer application on the Buick switch is now an issued patent. Indeed our belief that plaintiff actually knows the facts yet continues the mis-

---

<sup>2</sup> Petitioner seems to assert the exact contrary here, at page 9.

statements is confirmed by the fact that the complaint (R. 7) in the case at bar correctly refers to the Dyer application which shows Exhibit A-58 as having been involved in the interference. Unfortunately the Court of Appeals was misled in this matter and speaks of the Buick switch as having been in interference. The District Court had made no finding on this matter as there was no evidence offered on it. But petitioner can take no comfort from his success in misleading the court because the interference and the subsequent suit in the District of Columbia denied him priority and held that Lachapelle was the first inventor of the single count in the interference (*Gilbert v. Lachapelle et al.*, 127 F. [2d] 750).

The count involved in this interference (R. 4, par. Ninth) is really of no moment for it does not read upon the commercial Buick switch:

"A starter switch for internal combustion engines comprising, a circuit opening and closing means, pressure responsive means connected with the first named means for operating the latter means, an accelerator pedal, and control means for said pressure responsive means operatively connected with said accelerator pedal for controlling said pressure responsive means to hold the circuit opening and closing means in circuit opening condition."

In the Buick device neither the vacuum operated diaphragm nor any other pressure responsive means is "connected" to the "circuit opening and closing means" (which must be the switch contacts). Nor is the accelerator pedal "operatively connected" to a control means or the diaphragm or any other pressure responsive means for the purpose of "controlling said pressure responsive means to hold the circuit opening and closing means (the switch contacts) in circuit opening condition". As distinguished from Buick, the accelerator pedal of Gilbert's device is, in fact, "operatively connected" to the suction operated piston which carries the movable switch contact to hold the plunger down, i.e., in "circuit opening condition" when the accelerator is depressed.



In view of the foregoing, the fact that some other application of Dyer was involved in interference with Gilbert on this count, constitutes no admission that the *Buick switch* is the same as the switch of Gilbert in any particular.

If the issue of the interference did, in fact, apply to Buick the decision of the Court of Appeals for the District of Columbia would be an adjudication here (127 F. [2] 750), since it would be a holding that Gilbert did not originate it, which, on counsel's statement (*supra*, p. 3) is fatal to plaintiff's case.

### **The Prior Devices of Collins and Kauffman**

*Collins* had invented his accelerator-pedal-operated starter switch in August 1929 (R. 441)—the date is now conceded (R. 452)—and submitted it to defendant in January 1931. The original switch is in evidence (Ex. C-36 and a photograph, Ex. C-38, R. 732). Dyer was familiar with the Collins switch by September 15, 1931 (R. 637).

*Fundamental characteristics of Collins which are present in Buick but absent in Gilbert's switch (R. 519):*

(a) It is not a "key start" device but requires the manual depression of the accelerator pedal to close the starting circuit.

(b) The starter switch is not normally closed.

(c) The vacuum operated member does not move the switch contacts apart.

(d) Removal of the operator's foot from the accelerator when the engine stalls will not close the starter circuit.

(e) A spring is not used to close the starter switch.

(f) A spring is used to open the switch.

(g) Vacuum does not open the Collins switch, it *disables* the mechanical connection between the switch actuating

lever and the accelerator pedal which permits the switch to open by spring pressure.

(h) After the vacuum device has disabled the connection between accelerator pedal and switch lever, the accelerator is free to perform its normal function in the operation of the car and does not hold the switch open.

(i) Application of vacuum does not progressively decrease the contact pressure of the switch contacts.

(j) Fluctuations or ripples in the degree of vacuum will not cause the starter switch to chatter.

(k) Fluctuations in the vacuum can cause no damage to the pinion gear and ring gear of the starter system.

(l) The switch is not held in open position by vacuum, nor by depression of the accelerator.

*Kauffman* submitted several different types of switch to defendant and Dyer knew about them before he ever heard of Gilbert (R. 399).<sup>3</sup>

Two of the *Kauffman* switches (D-19 and D-27) are of particular importance for they negative invention in Gilbert and a third switch (D-23; D-24, R. 575) operates like the Buick switch, for vacuum *disconnects* the actuator from the switch. The original devices are all in evidence.

*Exhibit D-19.* This starter switch was described in detail by Mr. *Kauffman* (R. 473-6); it was designed in 1928 and embodies a means operated by the accelerator pedal to positively prevent closing of a suction opened control switch when the vacuum falls and is incapable of holding the switch open. It was installed on a Chrysler car and was in successful daily use by Mr. *Kauffman* as early as the early summer of 1928 (R. 473). J. W. McDonald who

---

<sup>3</sup> Petitioner is in error in saying that the Court of Appeals took this statement from respondent's brief there, and not from the record (Pet. p. 9).

was associated in business with Kauffman from 1927 to April 1929, corroborated the identification of the exhibit and stated (R. 498) that he had seen it installed on the Chrysler.

This switch is much like that of Gilbert in that the switch is operated by vacuum and held open by the accelerator pedal. Thus, as admitted by plaintiff's counsel, Gilbert can not prevail against defendant in any event, for he can not establish priority over Kauffman (R. 68).

*Exhibit D-27.* This switch of Kauffman is important because it was shown to defendant a *few days after August 31, 1931* (and therefore earlier than Gilbert's first assertion of submission). It is an improved form of D-19, operating in the same way, but designed for a different form of starter drive.

On August 27, 1931 Mr. Kauffman wrote (Ex. D-1; R. 733 to Mr. Mooney, then vice-president of defendant in charge of exports and told him about the switch of Exhibit D-27 and asked him for a letter of introduction. They had been classmates at the Case School of Applied Sciences in Cleveland (R. 457). On August 31, 1931, Mr. Mooney gave Kauffman two letters of introduction (Ex. D-3 and Ex. D-4; R. 736-737) and between that date and Labor Day, *he showed drawings* (Exs. D-7, 8, 9; R. 741-743) of *his switch and modifications of it* to Mr. C. E. Wilson (R. 459), vice-president of defendant. Then on October 16, 1931, Kauffman showed Exhibit D-27 to Mr. Hunt and left drawings of the device with him, and these drawings were sent on to Mr. Prescott at the Delco-Remy division at Anderson, Indiana.

*It is clear from the foregoing that a starter switch device, including means operated by the accelerator pedal to prevent closing of the switch at low vacuum, was submitted to defendant prior to any claimed submission by Gilbert of such a device.* Therefore the defendant can owe nothing to Gilbert, even if defendant had used such a device, which it did not do.

### Errors Urged by Petitioner

We shall now take up point by point the errors urged by petitioner and the reasons assigned for seeking a Writ. The record demonstrates, we believe, that the Courts below correctly found the facts and applied the law in dismissing the complaint.

*Error 1* (petition, p. 6): The fact is that there was *no* evidence whatsoever that Findley informed other employees what he learned about the device Watkins showed to him. Lovett, the patent attorney assigned to Delco (R. 408), Halblieb, general manager of the plant (R. 366), and Wallis, research engineer (R. 367), all knew and worked with Findley but never heard him mention Gilbert's starter, and no report was found in the files. Likewise Dyer specifically testified that he first learned of the Gilbert switch in the Spring of 1932 (R. 350) and had never even heard of Gilbert or his switch when he designed the Buick switch (R. 384). Petitioner admitted in his brief before the Court of Appeals that he had failed to make his point (p. 31). When Dyer did learn of Gilbert's switch he adapted none of it (R. 522).

*Error 2* (petition, p. 6): The submission to a manufacturer of a device devoid of novelty without any intention or understanding, by either party, that it was in confidence, raises no trust relationship with respect to the device. Neither Watkins nor anyone else stated that any of plaintiff's submissions were intended to be in confidence and Watkins' call on Findley was entirely voluntary (R. 101) and not at the request of Findley or anyone else in defendant's employ. But even if the law were otherwise, defendant did not in fact adopt plaintiff's switch nor profit by the submissions and there can be no liability under such a state of facts as this.

*Error 3* (petition, p. 6): Petitioner's only witness to the structure of defendant's switch was Mr. Frank Keiper, petitioner's attorney, and he admitted he could not tell how the device operated (R. 232). Petitioner makes no mention of his testimony. The burden of proving similarity of two devices just as in proving infringement in a patent case rests upon plaintiff who asserts it. But defendant did in fact prove, through its witness Dyer (R. 516-522), and by demonstrating the devices to the trial court, that the Buick switch is totally unlike that of Gilbert, in structure, mode of operation and result. Both courts found for defendant on this point (R. 39, findings 2 a to 2 j and R. 866).

*Error 4* (petition, p. 4): The fact is that there is substantial evidence in the record that the Buick switch and that of Gilbert are so essentially unlike that one could not have been copied from the other. The testimony of Dyer established the essential differences and there is no testimony to the contrary. The concurrent findings of the Courts below should not be disturbed for there is no conflict with courts in other Circuits.

*Thompson Spot Welder Company v. Ford Motor Company*, 265 U. S. 445, 447.

*Texas & New Orleans Railroad et al. v. Brotherhood of Railway & Steamship Clerks et al.*, 281 U. S. 548, 558.

*General Talking Pictures Corp. v. Western Electric Co. et al.*, 304 U. S. 175, 178.

*Error 5* (petition, p. 6): Dyer made drawing A-17 (R. 643) on September 29, 1931 (R. 359) and the Court of Appeals, affirming the District Court, correctly found that Dyer invented the defendant's switch. The court below likewise was not in error in holding that Dyer had the benefit of Collins and Kauffman; Dyer testified (R. 399) that he knew about Collins and the fact is also mentioned by Dyer in his report dated September 15, 1931 (R. 637).

Dyer also testified about his knowledge of Kauffman (R. 399) before he learned of Gilbert.

*Error 6* (petition, p. 7): There can be no interference, *as a matter of law*, between two devices which are so entirely dissimilar *in fact* as those of Buick and petitioner.

*Error 7* (petition, p. 7): Petitioner misconstrues the significance of Lachapelle. The switch of petitioner and that of Lachapelle (R. 500; Ex. E-2, R. 779) have three important features in common: both are "key-start" devices, in both vacuum pulls the switch contacts apart, and in both the accelerator pedal is used to *prevent* the closing of the switch contacts but performs no function in closing the switch. Applications covering these two switches were in interference and Lachapelle was awarded priority of the count by the Patent Office. Then followed an unsuccessful suit by plaintiff under Revised Statutes Section 4915 (35 U. S. C. 63 and 72a), affirmed on appeal by the Court of Appeals for the District of Columbia (127 F. [2d] 750). Therefore, between Gilbert and Lachapelle the latter has been determined to be the first inventor of the subject matter of the interference. As Lachapelle's assignee, defendant would be entitled to avail itself of the priority award to Lachapelle as against Gilbert but this has nothing to do with the present controversy because defendant does not manufacture and sell a starter which employs the three distinctive features common to the switch of Lachapelle and Gilbert, nor one which embodies the count of the interference (*supra*, p. 10).

*Error 8* (petition, p. 7): The courts below committed no error in regard to the proper interpretation of the Federal Rules of Civil Procedure and the evidence clearly established that plaintiff failed to prove his case.

*Error 9* (petition, p. 7): The record conclusively proves that there is no novelty in the Gilbert switch and that defendant did not copy any feature of it—either in structure

or operation. Independently of Gilbert Dyer designed an entirely different switch for Buick which in its principal features of construction and operation was the same as the earlier devices of Collins and Kauffman.

### Petitioner's Reasons

1 and 2 (petition, pp. 7, 8): The decision in the case at bar is not in conflict with the case of *Hoeltke v. C. M. Kemp Mfg. Co.*, 80 F. [2d] 912, nor with any of the cases cited on page 9 of the petition for the reason that the courts below concurrently found as a fact, upon substantial evidence, that the device of defendant and that of plaintiff were not similar and that defendant had not copied any feature of the plaintiff's switch.

On page 8, petitioner again states that in the interference Dyer swore that the Buick device was essentially the same as that of plaintiff; this is not the fact. The Dyer application there involved *was not the Buick switch*, as we have shown above (p. 9).

3 (petition, p. 9): This "reason" is based upon a misinterpretation of the Court of Appeals' opinion; what the Court did say in regard to Collins and Kauffman is supported by the evidence (R. 865, 866):

"In doing his work Dyer had the benefit of some other devices which had been submitted to the defendant and which should be mentioned briefly. One was by Collins \* \* \* a man by the name of Kauffman also submitted several devices which Dyer had available for use before he perfected the Buick switch and *before he became acquainted with the plaintiff's switch.*"

Dyer knew of Collins in September, 1931 (R. 637) and of Kauffman (R. 399) by October, 1931, whereas he did not learn of Gilbert until the Spring of 1932 (R. 350, 384).

4 (petition, p. 10): This section of the petition is so confused that it is impossible to understand what petitioner

intends. The only point about Lachapelle is that Gilbert cannot claim to be the inventor of even the count of the interference for priority was awarded to Lachapelle, so that if the count did read on Buick the plaintiff could not prevail in this case. However, defendant does not employ a structure which is within the description of the only claim involved in that interference (*supra*, p. 10). Certainly the cases cited are in no way in point and the case at bar is not in conflict with them.

5 (petition, p. 11): This section of the petition is based upon a misdescription of the Buick switch and a confusing comparison of an electric light socket for which there is no basis in the record. Also there is no basis in fact for reference to two helical springs above and below the diaphragm, "designed to force the contact points into the same place" (p. 12); it is merely an unjustified attempt to argue similarities in operation between Buick and Gilbert which do not exist. We have already stated the essential differences (*supra*, p. 5) between Gilbert and the Buick switch and they need not be repeated.

The footnote on page 3 asserts a date of 1928 for the invention of Gilbert's Exhibit 3 but the fact is that Gilbert failed to *prove* any date prior to the fall of 1931 for his switch. He had not one iota of documentary proof earlier than the application date (Oct. 10, 1931) and all his physical switches in evidence are of vague origin (R. 93) or admittedly constructed merely for the purposes of the trial.

6 (petition, p. 13): Petitioner asserts that Rule 36a was misconstrued by the Court of Appeals but none of the cases cited is an authority for the assertion.

The facts are these: prior to the trial plaintiff served upon defendant certain requests (R. 619) for admissions, each of the requests was duly answered and the answers (R. 855) served upon plaintiff and filed July 30, 1940. It is true that the answers were signed by one of defendant's attorneys and not sworn to, but plaintiff raised no



objection at the time. Six months later the case went to trial and still plaintiff made no point of the lack of oath to the answers; indeed he himself offered proof as to the subject matter of many of the requests and made no objection to defendant's offer of proof which conclusively established that plaintiff had not proven his case. Then after the conclusion of the trial plaintiff raised a question about the answers in a brief but thereafter seems to have abandoned it again for at the hearing on the settlement of findings of fact and conclusions of law before the District Judge, he made no mention of the matter and did not suggest a finding or conclusion in regard thereto. Certainly the Rules of Civil Procedure were never designed nor intended to permit plaintiff to stand by, and only after his own evidence and that of defendant had demonstrated he had no case, then to raise a technical objection which could have been corrected had the point been raised at the proper time. Rule 1 points to the intention and purpose of all the rules:

"These rules \* \* \* shall be construed to secure the just, speedy, and inexpensive determination of every action."

It would be contrary to every principle of justice to sustain a default based upon a point like this, tardily raised, and of no inherent merit. The opinion of the Court of Appeals remarks that it thought that if the absence of an oath to the answers was itself an admission of the truth of the requests, then plaintiff must prevail. The Court is in error about this for the requests (if deemed unanswered) do not establish that defendant has used the switch of plaintiff nor that there is any novelty in Gilbert's switch. The contrary to these two necessary elements of plaintiff's case have been established by clear and convincing evidence. The question of the interpretation of the Rule is moot in view of the proof that plaintiff, on the facts, is entitled to no recovery from defendant.

### Petitioner's Summary of Facts and Law

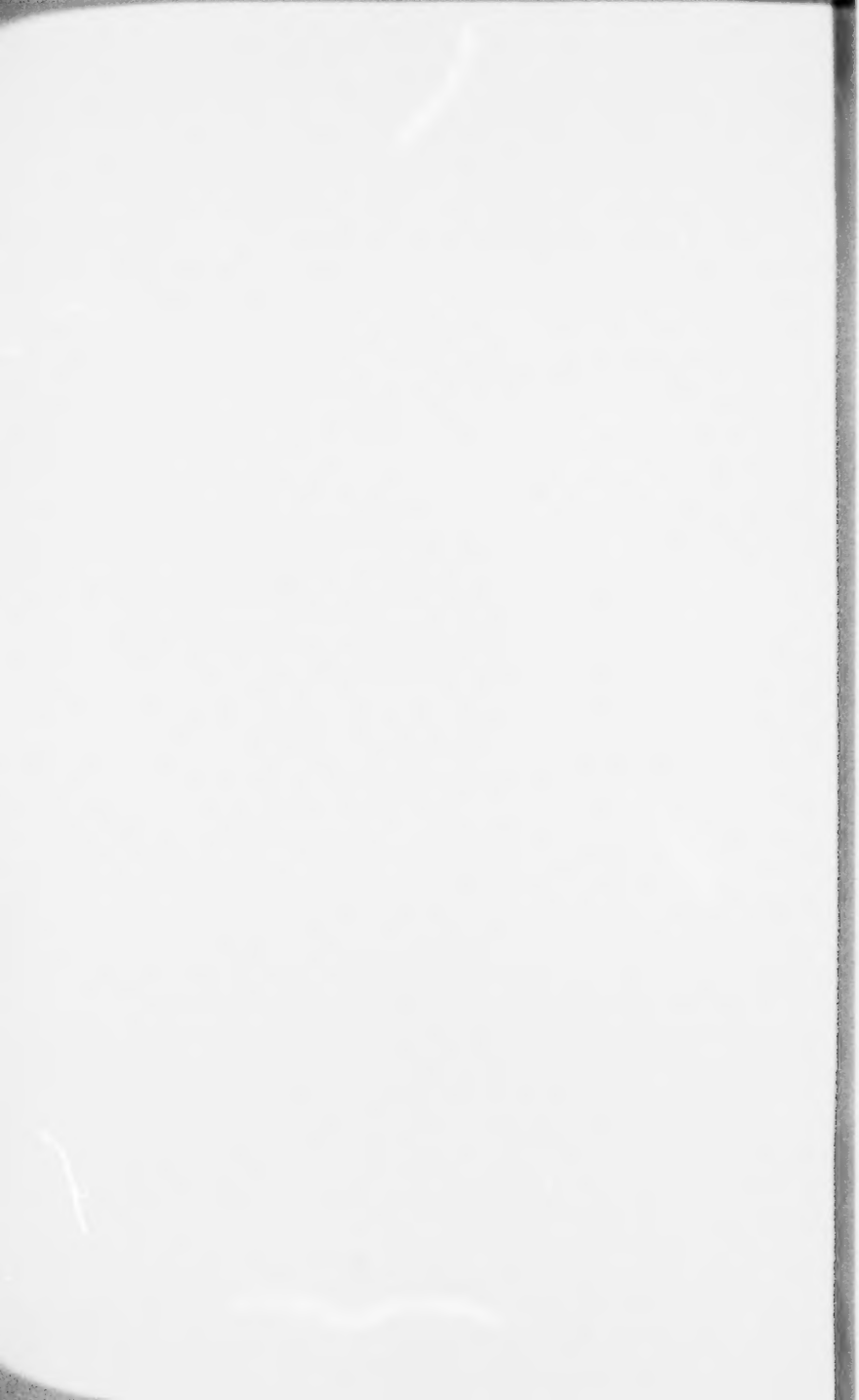
Petitioner states nothing which warrants the grant of the writ; the essential facts were correctly found by the courts below upon ample proof and the law correctly applied thereto. We call attention to the unjustified remarks under section (4) on page 19 of the petition; they are not only irrelevant to the issues here involved but are untrue; defendant did not "lie" to Kauffman nor is it true that it "stole" his invention. Also the assertion that the submission by Kauffman on October 16, 1931, was "too late" is not in point for Kauffman first got in touch with defendant on *August 27, 1931* (R. 733), through his old friend Mr. Mooney, Vice President of defendant, and had exhibited the drawings (R. 741-743) to Mr. Wilson, President of defendant (R. 459), *before Labor Day, 1931*. This was all prior to Gilbert's first submission in Rochester and long before Dyer ever heard of Gilbert.

### Conclusion

We submit that there is no conflict of decision between different Circuits and no question of public importance involved; that the facts found by the Courts below, concurrently, establish that defendant did not copy anything submitted to it by petitioner and therefore the case of *Hoeltke v. Kemp*, and other cases cited by petitioner, do not apply and the judgment is not in conflict with them. Wherefore the petition should be denied.

Respectfully,

DRURY W. COOPER,  
ALLAN C. BAKEWELL,  
Attorneys for Respondent.





(10)

Office - Supreme Court, U. S.  
**FILED**  
✓ APR 26 1943  
CHARLES ELMORE CROPLEY  
CLERK

**Supreme Court of the United States**  
**OCTOBER TERM 1942**

\_\_\_\_\_  
**No. 861**  
\_\_\_\_\_

**LEWIS W. GILBERT,**

*Petitioner,*

*vs.*

**GENERAL MOTORS CORPORATION,**

*Respondent.*

\_\_\_\_\_  
**REPLY BRIEF IN SUPPORT OF PETITION FOR  
WRIT OF CERTIORARI**  
\_\_\_\_\_

**JOHN D. MEYER,**

*Counsel for Petitioner.*

**HUGH J. O'BRIEN,**

**FRANK KEIPER,**

*Of Counsel.*



# INDEX

---

	Page
PART ONE	
Certain Statements Refuted .....	1
PART TWO	
The Importance of a Proper Construction of Rule 36a .....	8
CASES CITED	
Dupont de Nemours v. Masland, 244 U. S. 100 .....	3
The Harbour Trader, 42 Fed. (2nd) 858 .....	10
Hoeltke v. Kemp, 80 Fed. (2nd) 912, cert. den. 298 U. S. 673 .....	3
Port Gardner Investment Co. v. U. S., 272 U. S. 564 .....	10
Union Paper Bag Machine Co. v. Murphy, 97 U. S. 120 .....	8
United States v. One Ford Coupe, 272 U. S. 321 .....	10
STATUTE CITED	
National Prohibition Act, Title II Section 26, Title 27 U. S. C. Section 40 .....	9
RULE CITED	
Rule XI, Rules of the Circuit Court of Appeals for the Second Circuit .....	11





# Supreme Court of the United States

OCTOBER TERM 1942

---

No. 861

---

LEWIS W. GILBERT,

*Petitioner,*

*vs.*

GENERAL MOTORS CORPORATION,

*Respondent.*

---

## REPLY BRIEF FOR PETITIONER ON APPLICATION FOR WRIT OF CERTIORARI

---

### PART ONE

#### Certain Statements Refuted

#### I

Counsel correctly asserts that the primary issue in a copying case is one of fact, but that statement is subject to the limita-

tion that a finding of fact, made without evidence to support it, presents a question of law. On page 2 it is asserted that this question was answered in the negative by both Courts in the following language:

“The Buick switch has nothing in common with that of Gilbert except use of vacuum control and a mechanical connection to the accelerator. These features are entirely different in construction and function in the Buick device and that of Gilbert.”

But the first sentence of this statement is palpably erroneous. There is a third factor common to plaintiff and Buick, and not found in Collins. This is the central helical spring (two in Buick) to bring the contacts together (in plaintiff's device) and to bring the contacts into the same plane (in Buick). Without this neither device would function. It is not necessary to argue about this. The competing devices have been handed up to the Court (Exhibits 3, 4 and 7, plaintiff's device No. 4 having a window cut in the side, and Exhibits 39 and 40, defendant's device). Exhibit 39 as used on the trial, and submitted on the appeal, was not cut open far enough for the Court to see these springs. Since this apparently misled the Courts into making the statement quoted, we enlarged the cut in No. 39 to show these springs—to this Court. It is not a debatable question. Either those springs are there or they are not. All this Court needs to do is to look in the window of Exhibit 39 and see for itself.

And the finding of the Patent Office, resulting in the interference, becomes important here. If the elements of the count of the interference, set out in the ninth paragraph of the complaint (R 4) were taken away from either of the competing devices (Exhibits 3 and 39) we believe that neither would function. Again we shall not argue this. This Court is quite competent to form its own opinion by the most casual inspection of the two devices.

## II

Counsel quotes, as conclusive of something, the writer's statements appearing on pages 68 and 72 of the Record, to the effect that plaintiff must prove priority as against the world. These statements were erroneous (*Dupont de Nemours v. Masland*, 244 U. S. 100, *supra*) and were promptly corrected by defense counsel (R 70) who correctly stated the true rule, that the invention submitted needs only be novel as between the parties.

## III

Counsel next attacks the question of a confidential submission, claiming (a) that the evidence does not justify the findings of both Courts below as to what was submitted, and (b) that such evidence was insufficient on which to predicate a confidential relation. As to (a) the Courts below found with the petitioner, and respondent has so far acquiesced as to stipulate (R 585, 852) that Exhibit 7, now in this Court's hands, is a replica of the device Watkins brought to Rochester. This would seem to make this finding immune from the attack made on it on pages 3 and 4. The contention as to (b) would seem to be an attempt to reopen the question settled by this Court when it refused in *Hoeltke v. Kemp*, 80 Fed. 2nd 912, *supra*, not only to grant certiorari (298 U. S. 673) but also to listen to the pleas of the four largest motor companies, including the defendant to intervene and file a brief (298 U. S. 673).

## IV

Respondent again reasserts (pp. 6, 7) that the two devices are unlike, and again quotes the erroneous or defective finding of the Courts below. Iteration is not argument. But the statement on page 6, italicized, is that vacuum does not pull

the contacts apart in defendant's switch. Dyer, defendant's designer, who it is claimed devised defendant's switch, swears to the exact contrary on page 395, that is that the movement of the rod attached to the diaphragm helps break the contact. Of course, it would have to, or it would not be there.

Counsel's statement does not credit this Court with intelligence. It is the equivalent of saying that a transport plane from Washington to Pittsburgh carries passengers, but does not carry the engine nor the pilot, because they are together an integral part of the machinery.

In both devices (plaintiff's and defendant's) there are the following obvious points of similarity.

1. Both are totally enclosed, hollow or partly hollow, cylindrical metal containers.
2. In each there is a central helical spring which expands to bring the electrical contacts together.
3. In each there is a tube connected to the intake manifold of the engine.
4. In each the suction of the vacuum, operating through this tube, separates the contacts when the engine starts.
5. In each there is a wire or rod, connected to one of the parts which holds one of the contact points.
6. In each this wire or rod is connected to the accelerator pedal.
7. In each the function of this wire or rod is controlled by the accelerator pedal.
8. In each the function of this wire or rod is to prevent the points coming together when the vacuum falls.

Plaintiff's was the first switch submitted to defendant which contained all these elements. We concede that Dyer learned

something about Collins perhaps earlier than plaintiff's submission on September 10, 1931, though Dyer is quite indefinite about it (R 637). In other words, we believe Exhibit A 12 (ibid) to be genuine. But Collins had no central helical spring, as opposed to the action of the vacuum, but relied on gravity alone, a feature plaintiff had used in his patented switch in 1924 (R 572, 862, 863) but had discarded because of its unreliability (R 863). However, Dyer's drawing of September 10, 1931, which defendant stresses and to which the Court below refers (R 865) and which is found at page 640 of the record, owes nothing to Collins, for the Collins device (application 500947, R 703) was a vacuum controlled device, and Dyer's, as disclosed in the September 10, 1931 drawing referred to, (R 640) and in the two drawings following it (A 15, R 641, A 16, R 642) are *not vacuum controlled devices* (Dyer R 356, 357). He had not caught on to the idea, but on September 29, 1931 (Exhibit A 17, R 643, which is defendant's Skekinah, its Ark of the Covenant) he *had* caught on to the idea. *Where did he get it?* He disclaims invention in himself, and Collins could not lend him what Collins did not have.

Kauffman, says the defendant (brief pp. 13 and 14) and the Courts below argue without analysis (R 866). Kauffman, it is asserted, went to see defendant's vice-president Wilson on the Friday before Labor Day 1931, having a counterpart of defendant's Exhibit D 7 with him (R 459). He does not know whether he left it or not (R 460). But nothing came of this interview, so Kauffman went back again to Wilson *late in September 1931* (R 460) and Wilson arranged for him to see a man named Hunt (ibid). This he did on October 16, 1931. Hunt then wrote to Prescott, Dyer's superior at Anderson, Indiana, enclosing Kauffman's material, with opinion (letter Exhibit D 5, R 738). The blue prints were sent to Dayton, examined and forgotten. When Kauffman had the temerity to ask their return *three years later*, he was told by Hunt in writing *that he had submitted nothing new and that defendant had*

*derived no benefit from the submission.* (Letter Hunt to Kauffman R 740). It is evident that the information disclosed by the so-called submission to Wilson on the Friday before Labor Day (September 4, 1931) never reached Dyer at Anderson at all, and that he knew nothing of Kauffman until Hunt's letter of October 16, 1931 reached Prescott. *Otherwise, Dyer would have said so.* He does not, anywhere. Wilson could have said so, had it been the fact that he communicated the results of this interview to anybody at Anderson. He was not called.

This would seem to eliminate Collins, Kauffman and Dyer as originators or collaborators in the Buick switch, leaving only plaintiff as its source. True, Dyer denies this, but his uncorroborated denial does not meet the requirements of the law. (*Hoeltke v. Kemp*, 80 Fed. 2nd, 912, 923 *supra* cert. den. 298 U. S. 673).\*

We have no wish to quarrel with poor Kauffman, who seems to have been rather shabbily treated, but his testimony must be read in the light of the extraordinary document defendant compelled him to sign (R 562, see folio 1691 R 564) and of his frank admission on the witness stand (R 495).

## V

We are accused of misleading the Court (Brief pp. 9, 10) as to which of defendant's switches was involved in interference 68678. Our statements are taken from defendant's own evidence.

The Laboratory reports tell the story. Exhibit A-41, which defendant asserts is a drawing of A-58 bears the number "Ex.

---

\*NOTE—Kauffman and Collins were locked in *three* interferences, one earlier and two later than the Gilbert, Dyer, Lachappelle one which was 68678 (R 746, 748, 749, 751, 752, 754). It is apparent that the Patent Office found some essential similarity between Kauffman and Collins, and another and different similarity between Gilbert, Dyer and Lachappelle.

62322" in the lower right-hand corner (R 654), so does Exhibit A-42 (R 655). But "Ex. 62322" is "Ex. 10184" (R 663, fol. 1987), and the laboratory report (A-52, R 622) says, at folios 1986 and 1987, that this control switch "also latches so that it will not close again unless the throttle is closed." And on page 664, the laboratory reports on Dyer's redesigned switch. "The angular movement required to close this switch was made less on the new switch than it was on the old, in order to cut down the throttle opening when cranking (less than 1/3 open for new switch)—*otherwise the switches were the same.*"

And Dyer says the same thing. He says that Exhibit 53 (R 664) just quoted, is the laboratory report on A-58 as installed on Dawson's Oakland (fol. 1137, R 379, fol. 1133). It had already been tested on Mr. Wikle's car and the laboratory report is quite complete as to its operation (Ex. A-49, R 659, 660, fol. 1980). The "Note" there discloses that vacuum is also needed to pull the tangs apart.

And Dyer further says that A-59, A-58 and A-62 are substantially alike (R 373, fol. 1119) except that one uses a compression spring and the other a torque spring. After this, and slight other changes were made (Dyer R 375-377) development stopped.

Furthermore, respondent seems to contradict itself here. The commercial Buick switch (Exhibits 39, 40, A-62) is said (brief p. 9) to be a development of A-17, et seq (R 643, 644, 645, 646, 647, 648, 652) and that the one in the interference is a mysterious A-58, represented by drawings A-41 to A-47. If that were so, neither A-17 nor the working drawings which follow it, and enumerated above, would have been offered in evidence in interference 68678, as they all were. The notary's signature is on all of them.

However, the issue here is one of *copying*. It antedates the declaration of the interference, and the same claim would exist if nobody had filed in the Patent Office. The submission by Watkins to Findley at Rochester, New York, on September 10, 1931, was in confidence, and created a trust relationship. The appearance of defendant's device embodying all of plaintiff's ideas, called for an explanation from the defendant to disprove the charge of copying. This proof has taken the form of (a) an uncorroborated denial by Dyer and (b) the production of a fatherless device substantially different in form, but substantially accomplishing the same result and performing the same functions in substantially the same way (*Union Paper Bag Machine Co. v. Murphy*, 97 U. S. 120, 125).

## VI

We doubt that we have misunderstood the effect of the Patent Office controversy. Its result would be to award some kind of a patent to Lachappelle, but respondent denies using Lachappelle's features (brief p. 16). However, respondent admits first learning of Lachappelle in 1934 (Answer R 16, 18). This was after the present cause of action accrued.

## PART TWO

### **The Importance of a Proper Construction of Rule 36a**

1. Respondent contends that the question is moot, and that even if the "Requests" are to be taken as admissions, plaintiff must still fail. We doubt that respondent can stand on this assertion, for the Court of Appeals had held to the contrary (R 869). This is a ruling on a question of law, and like other rulings in questions of law, can be attacked on review only on an appeal by the aggrieved party.



2. But the correct interpretation of this Rule is of great practical importance, far transcending, in this Court, the rights and wrongs of individual litigants. The rule is in every day use in the District Courts, and the evil which will result from confusion over it can hardly be overstated, even though it is a procedural requirement. But on procedural requirements often hang the rights of parties in District Courts. We speak from actual experience. A single example may suffice. Section 26 of Title II of the National Prohibition Act (41 Stat. 415, now Title 27, Section 40, U. S. C.) contained the following provision:

“When the commissioner, his assistants, inspectors, or any officer of the law shall discover any person in the act of transporting in violation of the law, intoxicating liquors in any wagon, buggy, automobile, water or air craft, or other vehicle, it shall be his duty to seize any and all intoxicating liquors found therein being transported contrary to law. Whenever intoxicating liquors transported or possessed illegally shall be seized by an officer he shall take possession of the vehicle and team or automobile, boat, air or water craft, or any other conveyance, and shall arrest any person in charge thereof. Such officer shall at once proceed against the person arrested under the provisions of this chapter in any Court having competent jurisdiction; but the said vehicle or conveyance shall be returned to the owner upon execution by him of a good and valid bond, with sufficient sureties, in a sum double the value of the property, which said bond shall be approved by said officer and shall be conditioned to return said property to the custody of said officer on the day of trial to abide the judgment of the court. The court upon conviction of the person so arrested shall order the liquor destroyed, *and unless good cause to the contrary is shown by the owner*, shall order a sale by public auction of the property seized.”

This was interpreted as a procedural requirement, because the offending vehicle might be forfeited anyway under R S

3450, this section was unnecessary to provide a forfeiture. The District Courts differed about its construction, in view of the apparently alternative remedies open to the government (See cases cited in Title 27, U. S. C. A., p. 191 et seq.) An authoritative determination from this Court was sought and had in *Port Gardner Investment Co. v. U. S.*, 272 U. S. 564, and *United States v. One Ford Coupe*, 272 U. S. 321. In the *Port Gardner* case, this Court held that the procedure outlined in section 26 was mandatory.

Under the law thus settled the procedure was simplified. On the conviction of the driver, the Court, from the bench, would order the car forfeited and sold. There was no pretense of notifying the owner. He was not asked to show cause why his car should not be forfeited. Half of the time the enforcement officers did not know who he was, and at none of the time did they care, unless he could be implicated as *particeps criminis*. If the owner wanted to avoid the forfeiture, he must appear on the day of the trial of the driver and show his innocence. He was not entitled to notice (*U. S. v. Certain Quantity of Intoxicating Liquor*, 291 F. 717). Under this construction of the procedural provision of this section 26, containing the *unless* clause, literally thousands of forfeitures were decreed from the bench, without opinion. That the burden was on the owner to come forward was generally recognized, not only by all District Judges but by Appellate Courts, even by the distinguished jurist who wrote the opinion for the Circuit Court of Appeals in the case at bar (*The Harbour Trader*, 42 F. (2nd) 858, *supra*).

The point is that the District Judges have been taught that the sentence referred to in section 26, containing the "unless" clause, is mandatory and self executing. The present decision is to the exact contrary of this. How can there be harmony of opinion?

3. Plaintiff's "Requests" in this case, with proof of service, were offered and received without objection. They were offered as evidence, as admissions of the facts toward which the inquiries were directed, and stipulated as such (R 851). They are now, in effect, bodily stricken from the record on the ground that no proper foundation was laid for them (R 870). But if no proper foundation had been laid for their reception, was it not the duty of defendant-respondent to object there and then on that ground, and obtain a ruling from the Trial Court, so that, if they were excluded, the plaintiff might bring forward other evidence to supply their place? Our investigation has disclosed no case where an Appellate Court has been held justified in striking evidence received without objection, and this ruling is in direct conflict with Rule XI of the Court which rendered the decision.

### **Objections to Evidence in the Record**

"In all cases of equity or admiralty jurisdiction, heard in this Court, no objection shall be allowed to be taken to the admissibility of any testimony, deposition, deed, grant, exhibit, or translation found in the record as evidence, unless objection was taken thereto in the Court below and entered of record; but the same shall otherwise be deemed to have been admitted by consent."

Rule XI, Rules of the United States Circuit Court of Appeals, Second Circuit.

Under the guise of denying appellee's motion *ad diminuendo*, the Court has in effect granted it (R 870). It has usurped the power of the Trial Court to rule primarily on the admission of evidence. It has, in effect, added to the record responses which were not before the Court below. It has stricken out material evidence received by consent, and

decided the case without it. All this under the guise of interpreting Rule 36a, and placing upon it a construction it will not bear.

Respectfully submitted,

JOHN D. MEYER,  
*Counsel for Petitioner,*  
Gulf Building,  
Pittsburgh, Pennsylvania.

HUGH J. O'BRIEN,  
WERNER, HARRIS & TEW,  
FRANK KEIPER,  
Rochester, New York,  
*Of Counsel.*

